

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. Claims 1, 9, 13, 16, 17-23 have been amended. Claims 24-30 have been cancelled. No new claims have been added. No new matter has been added. Accordingly, Claims 1-23 (23 claims) will be pending in the present application upon entry of this Reply and Amendment.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

Status of Present Application

On October 20, 2005 the Examiner had rejected Claims 1-30 under 35 U.S.C. §103(a) as being unpatentable over Kolling (US Patent No. 5,963,925) in view of Krouse et al. (US Patent No. 6,097,834). Applicants timely filed an Appeal to the Final Office Action. Hereinafter, Applicants will refer to such Office Action as "Final Office Action."

On January 25, 2010 the Board of Patent Appeals and Interferences (hereinafter "Board") issued a decision on Applicants' Appeal. That decision affirmed the Examiner's rejection of Claims 1-15 of the present application and reversed the Examiner's rejection of Claims 16-30. However, the Board entered a new ground of rejection on Claims 1-30 under 37 CFR §41.50(b) and allowed Applicants to either reopen prosecution or request rehearing within two months from the date of the decision. Hereinafter, the Board decision will be referred to as "Appeal Decision." The new ground of rejection of Claims 16-30 is under 35 U.S.C. §112, second paragraph. (See Appeal Decision, page 15 through 16). The Board states on page 16 of the Appeal Decision "Accordingly, Claims 16, 24, and 28, and Claims 17-23, 25-27, 29 and 30 depend thereon, are rejected under 35 U.S.C. §112, second paragraph as indefinite.

March 25, 2010

Reply to Final Office Action of 10/20/2005
and the Appeal Decision decided 01/25/2010

Applicants request clarification with respect to the Appeal Decision wherein on page 17 of the Appeal Decision, the Board states "We conclude that the Applicants have not shown that the Examiner erred in rejecting Claims 1-15. We conclude that the Examiner erred in rejecting Claims 16-30. We enter new ground of rejection on Claims 1-30." As stated above, the Appeal Decision only entered new grounds of rejection on Claims 16-30 not Claims 1-30 as stated on page 17 of the Appeal Decision. The Appeal Decision does not provide any new ground of rejection for Claims 1-15. Accordingly, Applicants request clarification and correction.

Final Office Action

Claim Rejections - 35 U.S.C. §103

On page 2, para. 2 of the Final Office Action, the Examiner has rejected Claims 1-30 under 35 U.S.C. §103(a) as being unpatentable over Kolling (US Patent No. 5,963,925) in view of Krouse et al. (US Patent No. 6,097,834).

The Kolling et al. Patent. The Kolling et al. patent is an electronic bill presentment system which is only capable of accepting electronic billing information from billers and presenting it electronically to consumers. The Kolling et al. reference simply does not work with paper bills, and does not use paper statements or invoices in any way; in fact, there is not a single word in the entire Kolling et al. reference which deals with the issue of paper bills. Rather, the Kolling et al. reference "replaces the preparation and mailing of paper statements and invoices from a biller with electronic delivery." Abstract, lines 1-2 (emphasis added). The electronic statements, when displayed on the consumer's computer, have the same look as paper bills would have had (or formerly had).

The Krouse et al. Patent. The Krouse et al. reference is a walk-in bill payment system in which a customer brings a paper bill and physically walks into a location having a terminal for the walk-in bill payment system. As such, it is a completely manual

March 25, 2010

Reply to Final Office Action of 10/20/2005

and the Appeal Decision decided 01/25/2010

bill payment system which is incapable of presenting bills to customers, and which is electronic only in that payment to the biller is made by the walk-in bill payment system through the ACH/EFT system. The customer must bring a paper bill to the facility having the walk-in bill payment system terminal. The bill is scanned by the walk-in bill payment system terminal and if the walk-in bill payment system has been set up to work with a bill from that particular biller (if the bill is recognized as a bill from a biller which is included the walk-in bill payment system's database) the customer is presented with a screen displaying the amount of the bill and the consumer is asked how the consumer proposes to make payment. In the Krouse et al. patent, the consumer uses a debit card, enters the PIN associated with the debit card, and the walk-in bill payment system debits the consumer's bank account which is tied to the debit card and electronically transmits payment to the biller. It is important to differentiate presentment from payment; the Krouse et al. patent deals solely with payment, and is completely incapable of presenting a bill electronically.

Claim 1 of the present application is in independent form and recites a

"method of electronically presenting bills for at least one customer having an account from which funds may be drawn" comprising, in combination with other elements, the steps of: "...

establishing a bill center configured to receive all types of electronic and paper bills from billers of the customer, wherein the bill center is the sole source of electronically presenting the customer bills to the customer;
receiving by the bill center one of an electronic bill and a paper bill for said customer from at least one of said billers regardless of the format;

...
presenting in the bill center a seamless integration of said at least one electronic bill and said extracted billing information representative of said at least one paper bill to said customer;"

Claims 2-8 depend from independent Claim 1.

March 25, 2010

Reply to Final Office Action of 10/20/2005

and the Appeal Decision decided 01/25/2010

Claim 9 of the present application is in independent form and recites a "method of electronically presenting and paying paper-based bills for at least one customer having an account from which funds may be withdrawn," comprising, in combination with other elements, the steps of;

"receiving and processing in a bill center a paper bill for a customer wherein the bill center is configured to receive all types of paper bills, regardless of format and is a sole source of bills to the customer; ...

presenting in the bill center a seamless integration of said extracted billing information representative of said at least one paper bill to the customer."

Claims 10-12 depend from independent Claim 9.

Claim 13 of the present application is in independent form and recites a "method of electronically presenting and paying paper-based bills for at least one customer having an account from which funds may be withdrawn," comprising, in combination with other elements, the steps of :

"receiving in a bill center a paper bill a customer with the bill center configured to receive all types of paper bills, regardless of format; ...

receiving a payment instruction in the bill center ... wherein the bill center is the sole source of electronically presenting the customer bills and the sole source of bill payment for the customer."

Claims 14 and 15 depend from independent Claim 13.

Claim 16 of the present application is in independent form and recites a "system for electronically presenting and paying bills for at least one customer having an account from which funds may be withdrawn," comprising, in combination with other elements,

"a computer configured to allow a customer to subscribe to a bill presentation system for receiving electronic and paper-based bills for said customer; and

a bill center coupled to the computer ... wherein the bill center is the sole source of electronically presenting the customer bills to the customer in a seamless integration manner."

Claims 17-23 depend from independent Claim 16.

March 25, 2010

Reply to Final Office Action of 10/20/2005

and the Appeal Decision decided 01/25/2010

Support for the amendments to the claims can be found at least in the Specification as originally filed at page 14, lines 22; page 15, lines 13-21 through page 16, lines 1-9; page 16, lines 10-18; page 22, lines 5-10; and Figures 2 and 3 as originally filed.

Applicants have cancelled Claims 24-30.

The methods and system of electronically presenting bills for at least one customer having an account from which funds may be withdrawn as recited in independent Claims 1, 9, 13, and 16 would not have been obvious in view of Kolling, alone or in any proper combination with Krouse et al. under 35 U.S.C. §103(a). Kolling alone or in any proper combination with Krouse et al. does not disclose, teach or suggest a method and system of electronically presenting bills for at least one customer having an account from which funds may be withdrawn comprising, in combination with other elements, a bill center configured to receive all types of electronic and paper bills from billers of the customer, wherein the bill center is the sole source of electronically presenting the customer bills to the customer in a seamless integration manner. To transform the "electronic statement presentment system" of Kolling and the "financial transaction processing systems and methods" of Krouse et al. would require still further modification, and such modification is taught only by the Applicants' own disclosure. The suggestion to make the combination of Kolling and Krouse et al. has been taken from the Applicants' own Specification (using hindsight), which is improper.

"Obviousness requires the suggestion of all limitations in a claim." CFMT, Inc. v. Yieldup Intern. Corp., 349 F.2d 1333, 1342 (Fed. Cir. 2003) (citing In re Royka, 490 F.2d 981, 985 (CCPA 1974)). For a combination of references to render a claimed invention obvious, the references must teach or suggest each and every limitation of the invention as claimed.

The Applicants believe that the rejection of these claims is deficient for, among other things, two independent reasons, each individually sufficient to require the withdrawal of the rejection of these claims. First, the Kolling reference, alone or in any

March 25, 2010

Reply to Final Office Action of 10/20/2005
and the Appeal Decision decided 01/25/2010

proper combination with the Krouse et al. reference does not teach or suggest each and every limitation of the present claims. In the Final Office Action, the Examiner specifically states

"Kolling does not specifically teach receiving paper bills for conversion to electronic bills. Thus, Kolling does not specifically teach the steps of Kolling

receiving at least one paper bill for said customer from at least one of said billers;
identifying the contents of said paper bills;
scanning said at least one paper bill received for said customer to generate electronic image information; and validating the extracted billing information generated from said paper bill." (Page 5 of Final Office Action)

Krouse et al. does not provide that which is missing in Kolling.

Further, neither Kolling nor Krouse et al. provides a "bill center configured to receive all types of electronic and paper bills from the billers of the customers, wherein the bill center is the sole source of electronically presenting the customer bills to the customer in a seamless integration manner" as disclosed in the present application. Applicants submit that this alone is sufficient to show that the Examiner has not presented a *prima facie* case of obviousness.

Additionally, one having ordinary skill in the art would not be motivated to combine the Kolling reference with the Krouse et al. reference as proposed by the Examiner, because the combination teaches away from that which is disclosed and claimed in the present application and would render the Kolling reference unsuitable for its intended purpose. As stated above, Kolling is only capable of accepting electronic billing information from billers and presenting it electronically to consumers. The Kolling reference does not work with bill papers and does not use paper statements or invoices in any way. Kolling teaches the "replacement (of) the preparation and mailing of paper statements and invoices from a biller with electronic delivery." Abstract, lines 1-2 (emphasis added). The Krouse et al. reference is a walk-in bill payment system in

March 25, 2010

Reply to Final Office Action of 10/20/2005

and the Appeal Decision decided 01/25/2010

which the customer brings a paper bill and physically walks into a location having a terminal for the walk-in bill payment system. As such, there is a completely manual bill payment system which is incapable of presenting bills to customers. Therefore, there is no motivation to make the combination proposed by the Examiner, and such a combination does not support a finding of obviousness.

On page 6 of the Final Office Action, the Examiner states

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teachings of Krouse et al. into the system of Kolling in order to facilitate the conversion of paper bills into an electronic format for presenting to a customer. The motivation would have been to encourage billers who had not yet ready to transmit electronic bills to the bill processors of Kolling to do so and also to facilitate the processing and/or conversion of paper bills to electronic bills.

In response, the Applicants submit that combining Kolling with Krouse et al. as proposed by the Examiner would render Kolling unsuitable for its intended purpose. Specifically, the Kolling reference simply does not work with paper bills, and does not use paper statements or invoices in any way. There is nothing in Kolling to suggest that it deals with the issue of paper bills. The Krouse et al. patent, as stated above, is a walk-in bill payment system that requires a customer to physically walk to a location having a terminal for bill payments. The customer must bring the paper bill to the facility having the walk-in bill payment system terminal. Accordingly, the Examiner's stated motivation of encouraging billers to transmit electronic bills would not be facilitated by the Krouse et al. system which is directed to customers walking to a bill paying facility.

The suggested combination of Kolling and Krouse et al. by the Examiner would require Kolling to be modified to provide for a walk-in facility as taught by Krouse et al. which would render the Kolling reference unsatisfactory for its intended purpose of having a complete electronic billing system. "If proposed modification would render the

March 25, 2010

Reply to Final Office Action of 10/20/2005

and the Appeal Decision decided 01/25/2010

prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP 2143.01V.

Additionally, the further extensive modification to the Kolling reference necessary to make it compatible with the modification proposed by the Examiner, as well as its function, is taught only by the Applicants' own Specification. Use of the Applicants' own Specification as a blueprint in hindsight to support the conclusion of obviousness is improper.

Further, neither Kolling or Krouse et al. teaches a billing center which is the sole source of electronic presenting the customer bills to the customer in a seamless integration manner as disclosed and claimed in the present application. Any reasonable combination of Kolling and Krouse et al. (and Applicants are not acquiescence in such combination) would not result in a billing center as disclosed and claimed in the present application.

Because the Kolling reference alone does not teach or suggest each and every limitation of the present claims, as admitted by the Examiner in the Final Office Action as cited above, and because the modification to the Kolling reference with the Krouse et al. reference would render either Kolling or Krouse et al. unsuitable for its intended purpose, the present independent Claim 1, 9, 13, and 16 are allowable.

Dependent Claims 2-8 which depend from independent Claim 1; dependent Claims 10-12 which depend from independent Claim 9; dependent Claims 14 and 15 which depend from independent Claim 13; and dependent Claims 17-23 which depend from independent Claim 16 are also allowable (see 35 U.S.C. §112, para. 4.)

Applicants respectfully request that the Examiner withdraw the rejection of these claims.

Appeal Decision

In the Appeal Decision, page 10 under the Analysis, the Examiner addresses the rejection of Claims 1-30 under 35 U.S.C. §103(a) as being unpatentable over Kolling and Krouse et al. as set forth in the Final Office Action. The Examiner states that as to Claims 1-8 "We find that one of ordinary skill in the art would have been led by Kolling and Krouse et al. to the method of Claim 1. However, our reasoning below differs from that of the Examiner." The Appeal Decision states "... while our analysis focuses on making the "existing bill payment system" of Kolling (FF1) the bill payment system disclosed in Krouse et al. Therefore, we designate our rationale as a new ground of rejection."

The Board, in the Appeal Decision, states, on page 10 through lines 6 on page 11 that "claim 1 does not require that the *bill presentment system* receives the paper bill from the biller, as in the Examiner's proposed combination." "Claim 1 is silent as to who receives the bill and is silent as to who performs the remaining steps involving the paper biller information extracted from the bill. Further, Claim 1 includes the open transition "comprising" and therefore does not preclude other elements when those other elements than those recited. These steps are not limited to being performed by the bill presentment system, but could be performed by a customer or bill payment system."

In response, Applicants submit that each of independent Claims 1, 9, 13, and 16, as amended, require a *bill center* which is configured to receive all types of electronic and paper bills from billers of the customer and where the bill center is the sole source of electronically presenting customer bills to the customer. Accordingly, the claims, as amended, preclude anything or anyone other than the bill center of receiving bills of a customer regardless of the bill format.

The Board, in the Appeal Decision, also states "Second, given our construction above, we find that one ordinarily skilled in the art would have been led by Krouse et al. and Kolling to the method of Claim 1. In the teaching of Kolling and the teaching of

March 25, 2010

Reply to Final Office Action of 10/20/2005
and the Appeal Decision decided 01/25/2010

Krouse et al. are combined and discussed below, and the result is nothing more than the predictable use of elements of Kolling and Krouse et al. according to their established functions."

The Board attempts to support its conclusion that a combination of elements of Krouse et al. and Kolling would result in that which is disclosed and claimed in the present application by speculating that Kolling implies that some customers wish to or still do receive paper bills. (See Appeal Decision, page 12, lines 6-7). Such speculation is not supported by the facts. Kolling specifically states that the ESP system replaces the mailing of paper statements with electronic delivery. The Board also cites on page 12 of the Appeal Decision "Kolling also teaches that billers use legacy invoicing systems that allow bills to be printed or their consumer's financial institution can print the statement for delivery." Such teaching is away from that which is disclosed and claimed in the present application because the bill center as disclosed and claimed in the present application is the sole source of electronically presenting the customer bills to the customer. Accordingly, there can be no motivation in Kolling to modify its system as suggested by either the Examiner or the Board since Kolling allows for presentation of bills by more than one source which teaches away from what is disclosed and claimed in the present application.

On page 13 of the Appeal Decision, the Board states "While Krouse et al. teaches that the steps of receiving a paper bill is performed by a customer and the other steps are performed by the bill payment system, we note again that Claim 1 is silent as to who performs these steps and does not preclude a customer or a bill payment system from performing these steps."

In response, Applicants again submit that each of independent Claims 1, 9, 13, and 16 require a "bill center configured to receive all types of electronic and paper bills from bills of the customer, wherein the bill center is the sole source of electronically presenting the customer bills to the customer." (emphasis added) Therefore, the present application

March 25, 2010

Reply to Final Office Action of 10/20/2005

and the Appeal Decision decided 01/25/2010

discloses and claims that the bill center is the sole source of customer bills to the customer. (See also page 16, lines 6-9 of the Application as originally filed.)

On page 13 of the Appeal Decision, the Board states "When a patent "simply arranges old elements with each performing the same function as it had been known to perform" and use no more than one would expect from such an arrangement, the combination is obvious." KSR, 550 U.S. at 416 (quoting Sakraida v. Ag Pro, Inc., 425 U.S. 273, 282, 96 S. Ct. 1532 (1976)). The Board goes on to say "Accordingly, we find that one of ordinarily skill in the art would have been led by Krouse et al. and Kolling to the method of Claim 1. Therefore, we shall sustain the rejection of Claims 1-8."

In response, Applicants submit that the Board's reliance upon KSR is inapposite. In discussing the KSR case, the Federal Circuit in Ortho McNeil Pharmaceuticals, Inc. v. Mylan Laboratories, Inc., et al., 520 F.3d 1358, 1364-65 (Fed. Cir. 2008), confirmed that "A flexible TSM test *remains* the primary guarantor against a non-statutory hindsight analysis such has occurred in this case (emphasis added)." According to the Court, "The TSM test, flexibly applied, merely assures that the obviousness test precedes on the basis of *evidence* – teachings, suggestions (a telling broad term), or motivations (an equally broad term) – that arise before the time of invention as the statute requires (again, emphasis added)." *Id.* Thus, while invoking KSR to support its combination of two known systems with each performing the function that it has been known to perform, the Board (nor the Examiner) does not explain what facts are relied upon to establish the combination that would motivate the person of ordinary skill in the art at the time of the present invention. Implication of KSR does not absolve the Board (or the Examiner) of relying upon evidence. The lack of evidentiary support for the Board's invocation of KSR is a powerful indication that it is based upon impermissible hindsight.

With respect to Claims 9-12; Claims 13-15; and Claims 16-30, the Board, in the Appeal Decision, basically reiterated that their arguments with respect to Claims 1-8 are applicable to the other claims and therefore sustain the rejection of the Examiner or in the

March 25, 2010

Reply to Final Office Action of 10/20/2005

and the Appeal Decision decided 01/25/2010

alternative as a new ground to rejection. Applicants submit that their comments above with respect to the purported combination of Kolling and Krouse et al. either by the Examiner or the Board does not sustain a *prima facie* case of obviousness. Accordingly, Claims 1-23, as amended, are allowable and that the rejections under 35 U.S.C. §103(a) be withdrawn.

New Ground of Rejection

On pages 15 through 17 of the Appeal Decision, the Board has entered a new ground of rejection of Claims 16-30 under 35 U.S.C. §112, second paragraph. The Board states "Taking Claim 16 as representative, Claim 16 includes limitations in means-plus-function format, including "means for receiving at least one paper-based bill for said customer from at least one of said billers." (Appeal Decision, p. 15)

The Board states that the basis of the rejection is that the Board "cannot determine the structure that corresponds to the means for receiving at least one paper-based bill."

In response, Applicants have amended independent Claim 16 to eliminate the means-plus-function language and have also amended Claims 17-23 which depend from independent Claim 16 to remove the means-plus-function language. Applicants have also cancelled Claims 24-30.

Independent Claim 16, as amended, recites "A system for electronically presenting and paying bills for at least one customer having an account from which the funds may be withdrawn, comprising, in combination with other elements,

" a computer configured to allow a customer to subscribe to a bill presentation system for receiving electronic and paper-based bills for said customer; and

a bill center coupled to the computer, the bill center is configured to notify ..., receive ..., scan ..., extract ..., validate ..., and transmit ... information relating to bills associated with the customer and

wherein the bill center is the sole source of electronically presenting the customer bills to the customer in a seamless integration manner."

March 25, 2010

Reply to Final Office Action of 10/20/2005

and the Appeal Decision decided 01/25/2010

Support for these amendments can be found in the application as originally filed at least on pages 15-18 and Figures 2 and 3 of the present application. The various devices that make up the bill center 200 are illustrated specifically in Figure 3 and are described in the above-cited pages of the Specification, as well as the various inputs and outputs of the bill center in providing the sole source of electronic customer bills as claimed.

Applicants submit that independent Claim 16, and the claims that depend from it, are definite and in compliance with 35 U.S.C. §112, para. 2. Each of the elements of the claims, as informed by the Specification, will allow one ordinarily skilled in the art to practice the invention.

On page 16 of the Appeal Decision, the Board states "Since we cannot determine the corresponding structure of the means for receiving paper bills in the Specification, we cannot determine the scope of the claims."

In response, Applicants submit that independent Claim 16, as amended, provides that the bill center is configured to "receive at least one electronic bill for said customer regardless of format and to receive at least one paper-based bill for said customer from at least one of the said billers regardless of format." As informed by the Specification as originally filed, the bill center 200 is the sole source for receiving and paying the subscriber consumer bills. (See page 6, lines 7-9). At page 16, lines 10-13 the Specification states "electronic bills 340 can be received on magnetic tapes or optical discs that are sent to bill center 200, or can be received through a download over a private communications network. Electronic bills can also be received over public communication networks 310." Further on page 17, at line 9 the Specification, as originally filed, states "bill center 200 also received paper bills 340 from billers."

Applicants submit that MPEP §2173.05(g) states that

A function limitation must be evaluated and considered, just like any other limitation of the claim, for which it fully conveys to a person of ordinary skill in the pertinent art within a context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of

a process to define a particular capability or purpose that is served by the recited element, ingredient or step.

In the present application, it is disclosed and claimed that the bill center receives both electronic and paper bills of a customer, regardless of format and the bill center is the sole source of electronically presenting (and paying) the customer bills to the customer in a seamless integration manner. Further, Claim 17 which depends from independent Claim 16 states that the bill center is the sole source of bill payment for the customer. The method and systems as disclosed and claimed in the present application are structurally and functionally different from that which is disclosed in either Kolling or Krouse et al. and any reasonable combination of Kolling and Krouse et al. would not result in that which is disclosed and claimed in the present application, particularly a bill center that is the sole source of electronic presenting of customer bills to the customer.

Since Claims 16-23 have been amended and are definite and in compliance with 35 U.S.C. §112, para. 2, the Applicants respectfully request withdrawal of the rejection of Claims 16-23 under 35 U.S.C. §112, para. 2.

* * *

It is submitted that each outstanding objection and rejection to the application has been overcome, and that the application is in condition for allowance. The Applicant requests consideration and allowance of all pending claims (Claims 1-23).

Application No. 09/277,189
March 25, 2010
Reply to Final Office Action of 10/20/2005
and the Appeal Decision decided 01/25/2010

Page 23

The Examiner is invited to contact the undersigned by telephone as it is felt that a telephone interview would advance the prosecution of the present application.

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